

Appln. No. 10/637,118
Amdt. Dated May 29, 2007
Reply to Non-Final Official Action dated February 28, 2007

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 1. This sheet, which includes Figs. 1 and 2, replaces the original sheet including Figs 1 and 2. In Fig. 1, the previously omitted legend "Prior Art" has been added. Support for the requested changes may be found throughout the specification, the drawings and claims as originally filed. No new matter has been added.

Attachment: Replacement Sheet

REMARKS

Claims 1-5 and 11-22 are pending and at issue in the application with claims 1, 21 and 22 being the independent claims. Claims 1, 11, 16, 21 and 22 have been amended. Claims 6-10 have been cancelled. As a result, 3 independent claims remain in the application as previously paid for, and 17 total claims remain in the application as previously paid for. The applicant believes no fee is due. However, the commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

The action begins with an objection to the drawings. The applicant respectfully submits the objection to the drawings has been overcome. In particular, Fig. 1 has been amended to include the legend "Prior Art", as suggested in the action. Support for the amendment may be found throughout the originally filed application, including page 2, line 13 of the originally filed specification. No new matter has been entered.

The action further objects to the specification. The applicant respectfully submits the objection to the specification has been overcome. In particular, the title has been amended to be more indicative of the subject matter to which the claims are directed. Support for the amendment may be found throughout the originally filed application, including the originally filed claims. No new matter has been entered.

Turning to the claim rejections, claim 22 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicant respectfully traverses the rejection. The action asserts that independent claim 22 is directed to non-statutory subject matter without asserting whether the descriptive material of claim 22 is characterized as functional or nonfunctional descriptive material. At a minimum, the action has not presented a *prima facie* case that claim 22 is directed to non-statutory subject matter other than to merely assert the same. Further, a plain reading of independent claim 22 demonstrates that the claim clearly recites functional descriptive material (e.g., "to cause the destination server to act as a gateway...", "to cause the destination server ... to initiate the transfer of the users' mail folder and its contents ...", etc.) recorded on a computer-readable medium (e.g., "A computer

program product for ..."). Notably, the example of a computer readable-medium provided in the action (i.e., "A computer program product for ...") is precisely the language already recited in claim 22. Accordingly, the applicant submits that claim 22 recites statutory subject matter and complies with the requirements under 35 U.S.C. § 101, and the rejection must be withdrawn. Should any following action continue to reject any of the claims under 35 U.S.C. § 101, the applicant respectfully requests further explanation of the grounds for such a rejection, including specific citations to the Manual for Patent Examination Procedure.

Turning to the prior art rejections, claims 1-22 were rejected under 35 U.S.C. § 103 as unpatentable over Giroux et al. (U.S. Pat. No. 6,782,003) in view of Greenspan et al. (U.S. Pat. No. 6,850,484). The applicant respectfully traverses the rejections in light of the above amendments.

Independent claims 1, 21 and 22 have been amended, such that each of claims 1-5 and 11-22 recite a method, apparatus or computer program product for transferring users' e-mail accounts from a source server to a destination server, that includes automatically collecting information entered by the user at logon when the user logs on for the first time, and initiating the transfer of the user's mail folder and its contents from the source server to the destination server. By gathering and storing the user's logon information when the user logs on for the first time, there is no need for an administrator to request, for example, the password from the user or for the user to supply or change the password. The overall result is that the transfer of the user's e-mail account is completely transparent to the user.

The applicant respectfully submits that none of claims 1-5 or 11-22 are rendered unpatentable over Giroux et al. in view of Greenspan et al., because neither Giroux et al. nor Greenspan et al. disclose automatically collecting information entered by the user at logon and initiating the transfer of the user's mail folder and its contents from the source server to the destination server.

In particular, Giroux et al. does not disclose or suggest automatically collecting information entered by the user at logon when the user logs on for the first time, and initiating the transfer of the user's mail folder and its contents from the source server to the destination

server. While Giroux et al. discloses a method of replicating data on a source to a destination (see Abstract), Giroux et al. specifically requests information from the user including “the end user’s corresponding account identification and password,” as well as any other relevant information, in order to initiate the transfer. (See column 5, lines 51-67). In other words, Giroux et al. discloses that it is necessary for the end user to supply such information to initiate a transfer, rather than automatically collecting information entered by the user at logon when the user logs on for the first time and initiating the transfer, as recited by amended independent claims 1, 21 and 22. As a result, the transfer is not transparent to the user.

Likewise, while Greenspan et al. discloses redirecting and managing messaging and information access in a network (see Abstract), Greenspan et al. does not disclose automatically collecting information entered by the user at logon when the user logs on for the first time and initiating the transfer from the source to the destination. In particular, while Greenspan et al. discloses a server (stream manager) that acts as a gateway for a group of destination site servers, the server only determines the availability of a destination server to receive and process a message, but does not further disclose automatically collecting information entered by a user at logon and initiating the transfer, as recited by amended independent claims 1, 21 and 22. (See e.g., Abstract).

Accordingly, the combination of Giroux et al. and Greenspan et al. does not disclose or suggest all of the limitations of claims 1-5 and 11-22. It is clear that in order for a claim to be rendered unpatentable, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03.

Appl. No. 10/637,118
Amdt. Dated May 29, 2007
Reply to Non-Final Official Action dated February 28, 2007

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

By: _____

Aaron M. Peters
Registration No.: 48,801
Attorney for Applicant

May 28, 2007